

## REMARKS

## I. PRELIMINARY REMARKS

Claim 9 has been amended. No claims have been added or canceled. Claims 1-25 remain in the application. Reexamination and reconsideration of the application, as amended, are respectfully requested.

The typographical error based objection to claim 9 has been obviated by the amendment above.

## II. BRIEF DESCRIPTION OF AN EXEMPLARY EMBODIMENT

The present inventions, as defined by the claims, are directed generally to sound processors and to cochlear implant systems that include sound processors. Referring to Figure 3, which is reproduced below, a cochlear implant system 10' in accordance with one exemplary embodiment includes an implantable stimulator 12 and an **external** sound processor 50. The external sound processor 50 includes a coil 22 for transferring stimulation signals and power signals to the implantable stimulator 12. A power source 60 is permanently integrated into the external sound processor 50. To that end, in those instances where the permanently integrated power source 60 is rechargeable, the sound processor 50 may be provided with a coil 56 that receives power from an external charging source and recharges the power source. Alternatively, as illustrated in Figure 6, the permanently integrated power source 60 may receive recharging power by way of electrical contacts 61 and 62 that are carried on the surface or, or embedded within, the sound processor case.

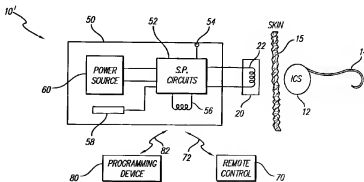


Figure 3 of the Present Application

There are a number of advantages associated with such sound processors and cochlear implant systems. For example, because the power source is permanently integrated into the present sound processor, the user does not have to carry and/or replace small sound processor batteries, as is the case with conventional sound processors. The present sound processors will also typically be smaller and have fewer components (i.e. no door, latch and/or electrical connectors for a removable battery) than sound processors with removable batteries. [See, e.g., paragraphs 0012-0016 of the present application.]

### III. PRIOR ART REJECTIONS

#### A. The Rejections

Claims 1-4, 6, 7 and 25 have been rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,272,382 to Faltys ("the Faltys patent"). Claim 21 has been rejected under 35 U.S.C. §§ 102 and/or 103 as being anticipated by and/or unpatentable over the Faltys patent.<sup>1</sup> Claims 5 and 8 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Faltys patent and U.S. Pat. Pub. No. 2002/0076071 naming Single ("the Single publication"). Claims 9-13, 15, 17-20 and 22-24 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Faltys patent and U.S. Patent No. 4,918,736 to Bordewijk ("the Bordewijk patent"). Claim 14 has been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Faltys patent, the Bordewijk patent and the Single publication. Claim 16 has been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Faltys patent, the Bordewijk patent and U.S. Patent No. 3,942,535 to Schulman ("the Schulman patent").

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<sup>1</sup> Claim 21 depends from independent claim 1. In view of the fact that independent claim 1 was not rejected based on 35 U.S.C. § 102, applicant has assumed for the purposes of this response that the Examiner only intended to reject claim 21 based on 35 U.S.C. § 103. **Clarification is hereby requested.**

The rejections under 35 U.S.C. § 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

## B. Discussion Concerning Claims 1-8 and 21

Independent claim 1 is directed to a sound processor for use with an implantable cochlear stimulator. The claimed sound processor comprises a combination of elements including, *inter alia*, “a headpiece ... adapted to transfer the stimulation signal and the power signal from the sound processing circuit to the implantable cochlear stimulator” and “a power source **permanently integrated into** the sound processor and adapted to provide operating power for the sound processing circuit and implantable cochlear stimulator.” The respective combinations defined by claims 2-8 and 21 include, *inter alia*, the elements recited in claim 1.

The Faltys patent fails to teach or suggest the claimed combinations. For example, the Office Action appears to have taken the position that the external speech processor illustrated in Figure 1A and described in column 7, lines 59-67 and column 8, lines 8-10 corresponds to claimed “sound processor.” [Office Action at pages 2 and 3.] The purported “sound processor” illustrated in Figure 1A includes a speech processor and “a power source (e.g., a replaceable battery)” within a wearable unit 102. [Column 7, lines 60-64.] The Faltys patent indicates that “the batteries employed within the wearable unit 102 (FIG. 1A) or the BTE unit 120 (FIG. 1B) may be readily replaced when needed.” [Column 9, lines 19-21.] As such, the power source in the speech processor illustrated in Figure 1A simply is not “**permanently** integrated into” the wearable unit 102.

Faced with this clear difference between the invention defined by independent claim 1 and the system illustrated in Figure 1A of the Faltys patent, as well as the lack of a suitable teaching reference, the Office Action simply based the obviousness determination on the following conclusory statement:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a power source permanently integrated into the sound processor, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put

together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

[Office Action at pages 3-4.]

Applicant respectfully submits that there are a variety of errors associated with the above-quoted statement and the conclusion of obviousness based thereon. For example, the claimed invention does not involve merely “forming in one piece an article which has formerly been formed in two pieces.” More importantly, however, is the fact that the Office Action impermissibly relied on a *per se* rule of obviousness. As noted in *In re Ochiai*, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995):

[t]he use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention-including all its limitations-with the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease.

See also *In re Cofer*, 148 USPQ 268, 271 (CCPA 1966) (“it is the facts appearing in the record, rather than prior decisions in and of themselves, which must support the legal conclusion of obviousness under 35 U.S.C. § 103”). The MPEP includes a similar admonition. In particular, MPEP § 2144.04 indicates that the Examiner may only use the rationale used by a court “**if the facts** in a prior legal decision **are sufficiently similar** to those in an application under examination.” [Emphasis added.] The present Office Action failed to so much as attempt to apply the facts of *Howard v. Detroit Stove Works* to the facts at issue here. Moreover, to the extent that a future Office Action may attempt to apply the facts of *Howard v. Detroit Stove Works* to the facts at issue here,<sup>2</sup> applicant notes that (1) the claims in *Howard* which appear to be relevant to the Examiner’s analysis involve metal casting and (2) the fact finder in *Howard* was presented with evidence (i.e. a prior art teaching) which showed that the modification of the primary reference was obvious. That is certainly not the case here.

Additionally, attached hereto as Exhibits 2-4 are copies of three Board of Patent Appeals and Interferences (“Board”) decisions that address rejections based solely on

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<sup>2</sup> A copy of *Howard v. Detroit Stove Works* is attached hereto as Exhibit 1 for the Examiner’s convenience.

an Examiner's interpretation of *Howard v. Detroit Stove Works*. Applicant stresses that these unpublished decisions **ARE NOT** binding precedent of the Board. Nevertheless, it is worth noting that in all three instances, *per se* rejections based on *Howard v. Detroit Stove Works* were **reversed**.

In view of the foregoing, applicant respectfully submits that the Office Action failed to establish a *prima facie* case of obviousness as to independent claim 1 and that the rejection of claims 1-4, 6, 7 and 21 under 35 U.S.C. § 103 should be withdrawn.

With respect to claims 5 and 8, applicant respectfully submits that the Single publication, which has been cited for its purported lithium battery teachings, fails to remedy the aforementioned deficiencies in the Faltys patent. Claims 5 and 8 are, therefore, patentable for at least the same reasons as independent claim 1 and the rejection of claims 5 and 8 under 35 U.S.C. § 103 should also be withdrawn.

### C. Discussion Concerning Claims 9-16, 22 and 23

Independent claim 9 is directed to a cochlear implant system that comprises "an implantable portion," "an external portion" and "a remote control unit." The ***external portion*** includes "a headpiece" and "a sound processor [that] comprises sound processing circuits, a coil and a ***battery permanently integrated into a closed case.***" The respective combinations defined by claims 10-16, 22 and 23 include, *inter alia*, the elements recited in claim 9.

The cited references fail to teach or suggest the claimed combinations. For example, and as discussed in detail above, the batteries employed in the Faltys wearable unit 102 (Figure 1A) "may be readily **replaced** when needed." [Column 9, lines 19-21, emphasis added.] The Bordewijk patent, which has been cited for its purported remote control teachings, fails to remedy the battery-related deficiencies in the Faltys patent.

Accordingly, even assuming for the sake of argument that there was some reason to combine their teachings in the manner proposed in the Office Action, the Faltys and Bordewijk patents fail to teach or suggest the combination of elements recited in

independent claim 9. The rejection of claims 9-13, 15, 22 and 23 under 35 U.S.C. § 103 should, therefore, be withdrawn.

***Applicant also notes that the Office Action failed to so much as attempt to address the “permanently integrated into” aspect of independent claim 9 and hereby requests that the next Office Action do so in order to clarify the issues in this application.*** For example, if the Examiner is taking the same “*Howard v. Detroit Stove Works*” position that was taken with respect to independent claim 1, applicant hereby requests that the next Office Action explicitly say so.

With respect to claim 14, applicant respectfully submits that the Single publication, which has been cited for its purported lithium battery teachings, fails to remedy the aforementioned deficiencies in the Faltys and Bordewijk patents. Claim 14 is, therefore, patentable for at least the same reasons as independent claim 9 and the rejection of claim 14 under 35 U.S.C. § 103 should also be withdrawn.

Turning to claim 16, applicant respectfully submits that the Schulman patent, which was cited for its purported external charging circuit teaching, fails to remedy the aforementioned deficiencies in the Faltys and Bordewijk patents. Claim 16 is, therefore, patentable for at least the same reasons as independent claim 9 and the rejection of claim 16 under 35 U.S.C. § 103 should also be withdrawn.

#### **D. Discussion Concerning Claims 17-20 and 24**

Independent claim 17 is directed to a cochlear implant system that comprises “an implantable portion,” “an external portion,” “a remote control unit” and “a base station.” The ***external portion*** includes “a headpiece” and “a sound processor [with] sound processing circuits, an antenna coil, a ***rechargeable battery integrally housed within a closed case***, and ***electrical contacts embedded within or carried on an exterior surface of the closed case*** that are in electrical contact with the rechargeable battery.” The respective combinations defined by claims 18-20 and 24 include, *inter alia*, the elements recited in claim 17.

The cited references fail to teach or suggest the claimed combinations. For example, the batteries employed in the Faltys wearable unit 102 (Figure 1A) “may be

readily **replaced** when needed.” [Column 9, lines 19-21, emphasis added.] As such, the batteries are not rechargeable, are not integrally housed with a closed case, and are not connected to electrical contacts on the exterior surface of the wearable (or BTE) unit. The Bordewijk patent, which has been cited for its purported remote control teachings, fails to remedy the battery-related deficiencies in the Faltys patent.

Accordingly, even assuming for the sake of argument that there was some reason to combine their teachings in the manner proposed in the Office Action, the Faltys and Bordewijk patents fail to teach or suggest the combination of elements recited in independent claim 17. The rejection of claims 17-20 and 24 under 35 U.S.C. § 103 should, therefore, be withdrawn.

***Applicant also notes that the Office Action failed to so much as attempt to address the “rechargeable battery integrally housed within a closed case” and “electrical contacts embedded within or carried on an exterior surface of the closed case” aspects of independent claim 17 and hereby requests that the next Office Action do so in order to clarify the issues in this application.*** For example, if the Examiner is taking the same “*Howard v. Detroit Stove Works*” position that was taken with respect to independent claim 1, applicant hereby requests that the next Office Action explicitly say so.

#### **E. Claim 25**

Independent claim 25 is directed to an “external sound processor for use with an implantable cochlear stimulator.” The external sound processor comprises “a microphone,” “a sound processing circuit,” “a rechargeable power source permanently connected to the sound processing circuit,” “**means for** mounting the microphone, sound processing circuit and rechargeable power source behind a human ear” and “**means**, carried by the means for mounting, **for** transferring power from an external power source to the rechargeable power source.” Applicant respectfully submits that the Faltys patent fails to teach or suggest the combination defined by claim 25.

For example, the external device illustrated in Figure 1A of the Faltys patent does not include (1) structure that performs the function of “mounting [a] microphone, sound

processing circuit and rechargeable power source behind a human ear” in combination with (2) structure, which is carried by the structure that performs the “mounting” function, that performs the function of “transferring power from an external power source to the rechargeable power source.”

In view of the foregoing, applicant respectfully submits that the Office Action failed to establish a *prima facie* case of obviousness as to independent claim 25 and that the rejection of claim 25 under 35 U.S.C. § 103 should be withdrawn.

Applicant also notes here that the Office Action failed to perform the requisite analysis under 35 U.S.C. § 112, sixth paragraph.<sup>3</sup> For example, the Office Action failed to identify the structures in one of the Faltys devices that perform the functions discussed above. Additionally, the Office Action did not indicate which portions of the invention defined by claim 25 are not disclosed in the Faltys patent and/or provide reasons for a modification of one of the Faltys devices that would produce claimed combination. ***Applicant hereby requests that the next Office Action perform the analysis required for rejections under 35 U.S.C. §§ 103 and 112, sixth paragraph, in order to clarify the issues in this application.***

#### F. Statement in the Office Action Regarding Claims 21, 22 and 24

The Office Action made the following statement concerning the “does not include a battery (or power source) removal door” aspect of claims 21,<sup>4</sup> 22 and 24:

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<sup>3</sup> The MPEP requires a ***two-part analysis*** of means-plus-function elements. ***First***, “the application of a prior art reference to a means or step plus function limitation ***requires*** that the prior art element ***perform the identical function*** specified in the claim.” [MPEP § 2182, emphasis added.] ***Second***, “***if a prior art reference teaches identity of function*** to that specified in a claim, ***then*** under *Donaldson* an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function.” [Id., emphasis added.]

<sup>4</sup> The Office Action actually referred to claim 20 instead of claim 21. Applicant has assumed for the purposes of this response that the reference to claim 20 was simply a typographical error. ***Clarification is hereby requested.***



Faltys makes no mention of a power source removal door within the sound processor case. To the contrary, Faltys discloses (col. 4, lines 5-23) replacement of the rechargeable battery would require removal of the entire ISP module. Therefore, the examiner considers Faltys' system to inherently not include a power source removal door. In the alternative, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a sound processor case that does not include a power source removal door, since such a door would be unnecessary for a battery that is permanently integrated into the sound processor.

[Office Action at pages 7 and 8.] Applicant respectfully submits that the presence or absence of a battery removal door on the ISP, i.e. the **implantable** speech processor, has nothing whatsoever to do the presence or absence of a battery removal door on the **external components** illustrated in Figure 1A of the Faltys patent, i.e. the purported "sound processor."

#### IV. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such

fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

April 20, 2007  
Date

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## **EXHIBIT 1**



<http://caselaw.findlaw.com>

## U.S. Supreme Court

**HOWARD v. DETROIT STOVE WORKS, 150 U.S. 164 (1893)**

**150 U.S. 164**

**HOWARD et al.**

**v.**

**DETROIT STOVE WORKS.**

**No. 64.**

**November 13, 1893. [150 U.S. 164, 165] Wm. G. Howard, for appellants.**

**Geo. H. Lothrop, for appellee.**

**Mr. Justice JACKSON delivered the opinion of the court.**

This suit was brought by appellants' testator, Philo D. Beckwith, against the appellee for the alleged infringement of three letters patent, viz. No. 123,142, issued January 30, 1872; No. 135,621, issued February 11, 1873; and No. 206,074, issued July 16, 1878,-all for improvements in heating stoves. The defenses set up and interposed were that the patents were all void for want of novelty and patentable invention. Pending the suit the patentee died, and the cause was revived and proceeded in the name of his executors. The court below dismissed the bill, and complainants appeal to this court to reverse that decree.

The first patent, issued January 30, 1872, relates to an improvement in stoves, wherein an exposed fire-pot section, cylindrical in shape, and tapering downwardly, is fitted into the upper end of a hollow ash-pit section. This fire pot has formed on the inner side of its lower end an annular flange, on which the grate rests. The theory of the patent is that this flange, which may be cast on or made separate from the fire pot, and riveted or otherwise fastened to it, is made of such a width that it will collect upon it a bank of ashes, which will have the effect of preventing undue expansion of the fire pot at the point of junction with the ash pit; or, in other words, the collection of ashes on the flange will prevent such an expansion of the lower end of the fire pot as would cause it to leave its seat on the ash pit, and expose an open joint at this point. The inventor stated in his application that he had found that the expansion of the fire pot is so great without the flange that the stove proves a failure, but, with the flange [150 U.S. 164, 166] cast on it at the point designated above, the joint will remain tight during the lifetime of the stove. The novelty involved in the patent consists entirely of the tapering cast-iron fire pot with the annular flange or shelf formed on its inside lower end at the point where it joins the ash pit, and upon which flange the grate rests. The single claim is 'the tapering cast-iron section, B, with the flange or shelf, c, framed on it, as described and shown.'

It was claimed by the appellee that this feature of the invention was so common in actual stove construction at the time the patent was issued as to be deemed obvious, and that prior patents, attaining the same results, had been granted, which practically covered the same design or

contrivance included in this particular patent. In support of this contention it was shown that a patent had been issued to Benjamin Brownell, on September 18, 1868, for a soft-coal hot-air furnace, in which it appears from the drawings set out in the record that a tapering fire pot is one of the elements of his invention, although it is not described in the specification. The drawings also indicate, and it was established by expert testimony, that this tapering fire pot had a flange on the inside lower end, upon which the grate rests. At the trial, a model of the Brownell patent was introduced, in which it was shown that the model differed from the patent drawings in having the projecting flange at the lower end of the fire pot formed on the ash pit, instead of on the fire pot.

The appellee further showed that a patent was issued to A. Atwood, May 14, 1850, (No. 7,356,) which has a flange projecting under the lower edge of the fire pot as wide as the outer rim of the grate. This flange is upon the ash pit, and not upon the fire pot. A patent issued to Bush & Richards (No. 171,129,) November 19, 1867, shows a construction like the Atwood patent, except that the fire pot is tapering.

It therefore appears in these three patents offered by the appellee, in support of its contention that the invention of the appellants had been anticipated, that they contain a clear and accurate representation of the contrivance of the Beckwith patent; that, even if the flange was formed on the ash pit [150 U.S. 164, 167] instead of on the fire pot, it was the equivalent thereof, because it performed the same function in the same way; and that the only function of the flange would be to collect a ring or bank of ashes at the base of the fire pot when the stove was in use.

If there is any material difference between the patent under consideration and those just discussed, it is found in the width of the flange. The appellants lay particular stress upon the fact that the width of the flange in the Beckwith patent—which was to serve the primary purpose of permitting a bank of ashes to form upon it which would have the effect of preventing the lower part of the fire box from becoming unduly heated—is greater than shown in the previous patents; but neither in the specification nor claim of the patent does the patentee indicate what shall be the width of this flange. The description of the invention is vague and indefinite, and is not sufficient to enable those skilled in the art to construct it without experiment so as to attain the desired result. The width of the flange is a mere matter of degree, and if at the time of the invention the proper width of the flange to accomplish the purpose desired was known, then the patentee made no invention. If the proper width was not known at that time, it should have been described in the patent; but, as the patent is silent on this point, except that the drawings indicate that the width of the outside rim of the grate is the proper width for the flange, it can hardly be said under such circumstances that the vague and indefinite description of the width of the flange elevates it to the dignity of invention, for it has been shown that the stoves covered by the patents just discussed also had each a flange which performed the same function, although not specifically claimed in the patents. We think it is obviously apparent that the patent of appellants' testator has not only been anticipated, but that it is wanting in all of the elements of patentable novelty.

The next patent to be considered is No. 135,631, issued February 11, 1873. This patent is for improvements in wood stoves, and consists of the construction, combination, and arrangements of the various co-operating devices comprising the parts of the stoves by joining them together with short [150 U.S. 164, 168] bolts or rivets, adapted to lugs or flanges, instead of long rods, which when exposed to the fire, are liable to be burned off several times during the life of the stove. The claims are four in number, but the third is not claimed to be infringed. The general form of the fire pot is the same as in the former patent, including the internal flange, which, it is alleged, now performs a triple function, viz. collecting ashes, as before; supporting the grate, as before; and securing the

ash pit to the fire pot by means of bolts or rivets passing through holes in the flange. The three claims in controversy are as follows:

'(1) The section A (ash pit) and section B, (fire-box,) constructed and secured together by means of bolts or rivets, and the internal flange, b, substantially as described.

'(2) The sheet-metal section, C, (body of the stove,) fitted into the fire pot, section B, and secured thereto by means of bolts or rivets, substantially as described.'

'(4) The top plate, or section G, secured to the section F by means of lugs and bolts or rivets, as set forth.'

The first claim of this patent is the same as covered by the former patent of Beckwith, except that the fire box and the ash pit in the former patent were not bolted together. The second and fourth claims are also found in the prior patent, except that the parts are not riveted together, and the top plate, or section G of claim 4, has in the older patent an annular depending flange entering the lower section, instead of lugs. In the present patent the flange is shown riveted to the lower section.

It is shown conclusively by letters patent issued to J. H. Keyser March 19, 1867, (No. 62,961,) and by No. 114,614, issued May 9, 1871, to Samuel Smith, and by patent No. 127,535, issued to H. Whittingham, that it was common to secure the various sections of stoves together by bolts and rivets; and unimpeached testimony shows that the Barstow Stove Company, of Providence, R. I., since 1856, has made a stove in which a cast-iron top and base are provided with lugs, through which holes are drilled for the purpose of riveting the sheet-iron body of the stove to the top and base. These claims, in view of the state of the art, limited the novelty to the use [150 U.S. 164, 169] of bolts and rivets, and it is too plain for discussion or the citation of authorities that this does not involve invention.

The third patent, (No. 206,074,) issued July 16, 1878, which the appellants claim has been infringed, contains two claims, both of which are in controversy, and substantially is for the invention of a circular grate having a thin closed portion, a thick open portion, strengthened by ribs, and with a toothed periphery opposite the open part of the grate. It appears from the record that a patent (No. 76,315) was issued to Mary E. A. W. Evard, on April 7, 1868, which describes a grate with a closed back and open front, and the drawing in the patent clearly shows that the open front is thicker than the closed back, and forms ribs on the closed back. The only difference between this grate and the one under consideration is that the Evard one is rectangular, to fit a rectangular fire box, while the Beckwith grate is circular, to fit a circular fire box. The prior use of the elements contained in this patent are conclusively shown. The Rambler grate answers the first claim, except that both the open and closed parts are of the same thickness. The North American and Morning and Evening Star grates answer the first claim literally, except that they are rectangular, instead of circular, and provided with holes in the plate part of the grate, where the Beckwith grate has none. At the date of this invention it was common to make wood-burning grates partly open and partly closed, with teeth at their ends, which serve exactly the same purpose as the teeth, D, of the patent. These grates are all used in cooking stoves, and are rectangular in form, while the Beckwith patent is circular in shape; but it cannot be maintained that there is any element of invention in making the grate fit the particular fire box of the stove to be constructed. To accomplish that end mechanical skill alone is necessary, and does not call for the exercise of inventive talent.

The appellants urge that the word 'periphery' is a word of limitation, confined to a circular grate. However this may be, it is conclusively shown that the Monumental grate, which was in public use five years before application was made for the patent under consideration, contains all of the elements of [150 U.S. 164, 170] the Beckwith grate, except that, being adapted for burning coal, it is cast in two pieces, while the Beckwith grate is cast in one piece. This does not involve patentable invention.

Our conclusions are that as to the first patent it was anticipated by prior patents, and is void for want of invention in not describing how wide the flange should be in order to accomplish the desired result. As to the second patent, it is void because the bolting or riveting together of sections of a stove was well known at the time of the invention, and the use of lugs with holes perforated through them was anticipated in other stoves and furnaces manufactured many years prior to the date of the patent. As to the third patent, it is void because the claims in it were clearly anticipated, and because it involves no invention to cast in one piece an article which has formerly been cast in two pieces, and put together; nor to make the shape of the grate correspond with that of the fire pot.

Our opinion is that the judgment of the court below dismissing the bill should be affirmed.

Mr. Justice GRAY was not present at the argument, and took no part in the decision.

## **EXHIBIT 2**



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 36

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Ex parte JOHN MUSACCHIA



Appeal No. 2004-0430  
Application No. 09/174,868

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 to 18, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates generally to a hunting device for calling game. Particularly, the appellant's invention relates to an improved game call device of unitary construction having a game call portion and a platform portion. The game call portion is that portion of the appellant's invention that produces the calling sounds. Further, the appellant's game call can be retained securely relative to a hunter's body, and is elevated from the hunter's body by the platform portion. Thus, the hunter has instant, ready access to the appellant's call when secured to the body while the field performance of the appellant's invention, having percussive or friction-generated type game call portions, is not compromised (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Musacchia

5,607,091

Mar. 4, 1997

Claims 1 and 3 to 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Musacchia.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 24, mailed September 24, 2002) and the answer (Paper No. 30, mailed April 29, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 27, filed March 24, 2003) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 and 3 to 18 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is

established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

In the rejection under 35 U.S.C. § 103 before us in this appeal (final rejection, pp. 2-5), the examiner (1) set forth the pertinent teachings of Musacchia's hunting device for producing sound; (2) ascertained that "Musacchia discloses the claimed invention except for the game call device constructed as one piece as recited in claims 1, 10, 14 and 17" (the independent claims on appeal); and (3) concluded that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the game call device as one piece, since it has been held that forming in one piece an article which has been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

The examiner has incorrectly drawn from the above-noted case law, which turned on specific facts, a general obviousness rule: namely, that forming several pieces integrally as a one-piece structure would have been obvious at the time the

invention was made to a person of ordinary skill in the art. No such per se rule exists.<sup>1</sup> See In re Hubbell, 164 F.2d 700, 702-04 76 USPQ 105, 107-09 (CCPA 1947); In re Otto, 121 F.2d 553, 555, 50 USPQ 149, 150 (CCPA 1941). The examiner's citation of Howard or any other case as a basis for rejecting claims that differ from the prior art by reciting a one-piece structure is improper, if it sidesteps the fact-intensive inquiry mandated by 35 U.S.C. § 103. Thus, in this case, one must determine if it would have been obvious to one of ordinary skill in the art at the time the invention was made to make Musacchia's separate call and platform as a one-piece structure.

In this case, we agree with the appellant that the examiner has failed to establish a prima facie case of obviousness for the claims under appeal with respect to the one-piece limitation as recited in claims 1, 10, 14 and 17. In that regard, it is our determination that there is no evidence before us in this appeal that the one-piece

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<sup>1</sup> In Howard the Supreme Court stated (150 U.S. at 169-70) that the Monumental grate, which was in public use five years before application was made for the patent under consideration, contains all of the elements of the Beckwith grate, except that, being adapted for burning coal, it is cast in two pieces, while the Beckwith grate is cast in one piece. This does not involve patentable invention.

... As to the third patent, it is void because the claims in it were clearly anticipated, and because it involves no invention to cast in one piece an article which has formerly been cast in two pieces, and put together.

In Howard, prior art other the Monumental grate taught casting the grate in one piece. Thus, providing evidence as to why it would have been obvious at the time Beckwith's invention was made to a person of ordinary skill in the art to have cast the Monumental grate as one piece.

limitation would have been obvious to one of ordinary skill in the art at the time the invention was made from the teachings of Musacchia.

For the reasons set forth above, we conclude that the examiner's determination of the obviousness of the one-piece limitation has not been supported by any evidence<sup>2</sup> that would have led an artisan to arrive at the claimed invention. In our view, the only suggestion for modifying Musacchia in the manner proposed by the examiner in the rejection before us in this appeal to meet the one piece limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

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<sup>2</sup> Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l, Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Roufflet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability (such as making plural elements into a single-piece assembly), that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002) and In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

For the reasons set forth above, we are constrained to reverse the decision of the examiner to reject independent claims 1, 10, 14 and 17, and claims 3 to 9, 11 to 13, 15, 16, 17 and 18 dependent thereon, under 35 U.S.C. § 103.

REMAND

We remand this application to the examiner for further consideration of the patentability of claims 1 and 3 to 18. Specifically, we remand this application to the examiner to ascertain if there is any prior art evidence establishing that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Musacchia's hunting device to arrive at the claimed invention.

## CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 3 to 18 under 35 U.S.C. § 103 is reversed. In addition, we have remanded this application to the examiner for further consideration.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

## REVERSED and REMANDED

IRWIN CHARLES COHEN  
Administrative Patent Judge

*Lawrence J. Staab*  
LAWRENCE J. STAAB  
Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES



Appeal No. 2004-0430  
Application No. 09/174,868

Page 9

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JVN/jg

## **EXHIBIT 3**

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Ex parte MICHAEL SCOTT

Appeal No. 2005-0254  
Application No. 10/197,012

ON BRIEF

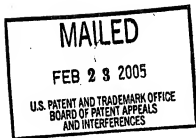
Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3 and 6, which are all of the claims pending in this application.<sup>1</sup>

We REVERSE.

<sup>1</sup> Claims 1 and 6 were amended after the final rejection. Claims 4 and 5 were canceled subsequent to the final rejection.



BACKGROUND

The appellant's invention relates to a ribbon supply spool for an apparatus for feeding ribbon to a print station and is directed to features which enable the ribbon supply spool and ribbon take-up spool to be simpler to make and use, and to contain an increased length of ribbon (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 1 to 3 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,374,007<sup>2</sup> to Murison.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (mailed May 18, 2004) for the examiner's complete reasoning in support of the rejection, and to the brief (filed March 18, 2004) and reply brief (filed July 13, 2004) for the appellant's arguments thereagainst.

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<sup>2</sup> Issued December 20, 1994.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied patent to Murison, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 3 and 6 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the applied prior art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

In the rejection under 35 U.S.C. § 103 before us in this appeal (answer, pp. 3-4), the examiner (1) set forth the pertinent teachings of Murison; (2) ascertained that "Murison discloses the claimed invention except for having an additional tubular core member 54 on the cylindrical member 56; and (3) concluded that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the tubular core member 54 integral with the cylindrical member 56, thus resulting in an "integral, one-piece spool", to simplify the spool and have fewer parts, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

The examiner has incorrectly drawn from the above-noted case law, which turned on specific facts, a general obviousness rule: namely, that forming several pieces integrally as a one-piece structure would have been obvious at the time the invention was made to a person of ordinary skill in the art. No such per se rule exists.<sup>3</sup>

See In re Hubbell, 164 F.2d 700, 702-04 76 USPQ 105, 107-09 (CCPA 1947); In re

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<sup>3</sup> In Howard the Supreme Court stated (150 U.S. at 169-70) that the Monumental grate, which was in public use five years before application was made for the patent under consideration, contains all of the elements of the Beckwith grate, except that, being adapted for burning coal, it is cast in two pieces, while the Beckwith grate is cast in one piece. This does not involve patentable invention.

... As to the third patent, it is void because the claims in it were clearly anticipated, and because it involves no invention to cast in one piece an article which has formerly been cast in two pieces, and put together.

In Howard, prior art other than the Monumental grate taught casting the grate in one piece; thus, providing evidence as to why it would have been obvious at the time Beckwith's invention was made to a person of ordinary skill in the art to have cast the Monumental grate as one piece.

Otto, 121 F.2d 553, 555, 50 USPQ 149, 150 (CCPA 1941). The examiner's citation of Howard or any other case as a basis for rejecting claims that differ from the prior art by reciting a one-piece structure is improper, if it sidesteps the fact-intensive inquiry mandated by 35 U.S.C. § 103. Thus, in this case, one must determine if it would have been obvious to one of ordinary skill in the art at the time the invention was made to make Murison's tubular core member 54 and ribbon spool 22<sup>4</sup> as a one-piece structure.

In this case, we agree with the appellant that the examiner has failed to establish a prima facie case of obviousness for the claims under appeal with respect to the one-piece printer ribbon spool limitation as recited in claim 1.<sup>5</sup> In that regard, it is our determination that there is no evidence before us in the rejection under appeal that the one-piece printer ribbon spool limitation as recited in claim 1 would have been obvious to one of ordinary skill in the art at the time the invention was made from the teachings of Murison.

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<sup>4</sup> Murison's ribbon spool 22 includes the cylindrical member 56 on which the tubular core member 54 is mounted.

<sup>5</sup> The one-piece printer ribbon spool limitation as recited in claim 1 requires, inter alia, that the one-piece printer ribbon spool comprises an elongate cylindrical ribbon support shaft of substantially uniform diameter, having directly wound thereon a length of a printing ribbon.

For the reasons set forth above, we conclude that the examiner's determination of the obviousness of the one-piece printer ribbon spool limitation has not been supported by any evidence<sup>6</sup> that would have led an artisan to arrive at the claimed invention. In our view, the only suggestion for modifying Murison in the manner proposed by the examiner in the rejection before us in this appeal to meet the one piece printer ribbon spool limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

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<sup>6</sup> Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l, Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability (such as making plural elements into a single-piece assembly), that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002) and In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).




For the reasons set forth above, we are constrained to reverse the decision of the examiner to reject independent claim 1, and claims 2, 3 and 6 dependent thereon, under 35 U.S.C. § 103.


CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3 and 6 under 35 U.S.C. § 103 is reversed.

REVERSED

  
IRWIN CHARLES COHEN  
Administrative Patent Judge

  
CHARLES E. FRANKFORT  
Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

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Appeal No. 2005-0254  
Application No. 10/197,012

Page 8

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JVN/jg

## **EXHIBIT 4**

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** FRANK JOHN MUENCH, Jr., GORDON THOMAS BORCK  
and ALLEN LEROY JOHNSON

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Appeal No. 2001-0114  
Application 09/240,712

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ON BRIEF

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Before HAIRSTON, FLEMING, and GROSS, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of claims 1 through 12 and 16 through 27.

The invention relates to a current limiting fuse. Figure 1 shows a cutaway side view of a current limiting fuse of the invention with two winding supports. See page 3, lines 31 through 32, of Appellants' specification. In particular, the

winding supports 105, 110 are contained in a cylindrical tube 135 that is sealed on each end by caps 140, 145. The caps 140, 145 are connected to plates 150 and 155 which are mounted to the ends of the winding supports 105, 110. See page 4, lines 28 through 32 of Appellants' specification. Appellants disclose on pages 6 and 7 of the specification that using a separate winding support for each element reduces problems associated with maintaining the separation between the elements in operation and in filling the fuse with silica sand. Furthermore, the winding support allows control and maintenance of the positioning needed for proper operation. See page 6, line 29, through page 7, line 5, of Appellants' specification. Furthermore, the end plates 145, 150 support and position the individual winding supports thereby fixing the winding supports 105 and 110 to prevent movement of the elements that could adversely affect the operation of the fuse. See page 7, lines 1 through 5, of Appellants' specification.

Representative claims 1 and 16 are reproduced as follows:

1. A high current fuse comprising:  
a housing;

a first electrically-conductive cap attached to a first end of the housing;

a second electrically-conductive cap attached to a second end of the housing;

at least two winding supports positioned in the housing, extending between the caps, and spaced from one another;

at least one electrically-conductive element wound around a first one of the winding supports and electrically connected to the caps; and

at least one electrically-conductive element wound around a second one of the winding supports and electrically connected to the caps;

wherein at least a portion of both of the two winding supports is defined by a single structure.

16. A high current fuse comprising;

a housing defining a central longitudinal axis;

a first electrically-conductive cap attached to a first end of the housing;

a second electrically-conductive cap attached to a second end of the housing;

at least two non-coaxial winding supports positioned in the housing spaced from one another and extending between the caps;

at least one electrically-conductive element wound around a first one of the winding supports and electrically connected to the caps; and

at least one electrically-conductive element wound around a second one of the winding supports and electrically connected to the caps;

wherein at least a portion of both of the two non-coaxial winding supports is defined by a single structure.

#### **REFERENCES**

The references relied on by the Examiner are as follows:

Grzeczowski	3,145,282	Aug. 18, 1964
Cameron	3,569,891	Mar. 9, 1971
Knapp, Jr.	3,962,666	Jun. 8, 1976

**REJECTION AT ISSUE**

Claims 1 through 4, 7 through 12, 16 through 21 and 24 through 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Grzeczowski.

Claims 5 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Grzeczowski in view of Knapp.

Claims 6 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Grzeczowski in view of Knapp and Cameron.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the briefs<sup>1</sup> and answer for the respective details thereof.

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<sup>1</sup>Appellants filed an appeal brief on July 7, 2000. Appellants filed a reply brief on October 10, 2000. The Examiner mailed an office communication on November 30, 2001, stating the reply brief has been entered and considered.

**OPINION**

After a careful review, we will not sustain the Examiner's rejection of claims 1 through 12 and 16 through 27 under 35 U.S.C. § 103.

Appellants argue on page 4 of the brief that Grzeczkowski fails to teach or suggest "wherein at least a portion of both of the two winding supports is defined by a single structure" as recited in claim 1. Appellants also argue on page 6 of the brief that Grzeczkowski fails to teach or suggest "wherein at least a portion of both of the two non-coaxial winding supports is defined by a single structure" as recited in claim 16.

On page 3 of the final rejection, the Examiner admits that Grzeczkowski does not teach a single structure for providing a pair of winding supports as recited in claim 1. Similarly on page 4 of the final rejection, the Examiner admits that Grzeczkowski fails to teach that at least a portion of both of the two winding supports is defined by a single structure as recited in Appellants' claim 16. The Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the two winding supports into a single structure as an obvious design choice because it has been held by case law that forming one



piece in an article which has been formerly formed into two pieces and put together involves only routine skill in the art. The Examiner relies on **Howard v. Detroit Stove Works**, 150 U.S. 164 (1893). See pages 3 and 4, of the Examiner's final rejection. In the Examiner's answer, the Examiner maintains that **Howard v. Detroit Stove Works** holds that it is within one of design choice to form one piece of article which has formerly been formed into two pieces and putting them together involves only routine skill in the art. See pages 3 and 4 of the Examiner's answer.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming

forward with evidence or argument shift to the Appellants.

**Oetiker**, 977 F.2d at 1445, 24 USPQ at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or individual to combine the relevant teachings of the references.'" *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), *citing In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617. "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617, *citing McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

"In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." *In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on

evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). With these principles in mind, we commence review of the pertinent evidence and arguments of Appellants and Examiner.

Upon our view of the evidence, we find that the record fails to show any suggestion to lead one of ordinary skill in the art to make the modification as proposed by the Examiner. In particular, we note that the Examiner's assertion that this modification is a matter of design choice is only a conclusionary statement not based on genuine issue of material fact. In particular, we note that the claims all require a single structure for providing a pair of winding supports. This structure corresponds to elements 155 and 150 shown in figure 1. Furthermore, we note that this structure is not a nonfunctional limitation but indeed has a function. Appellants' specification discloses on pages 6 and 7 that the end plates 145 and 150 of the two winding supports 105 and 110 provide the function of maintaining the separation between the elements in

operation and filling the fuse with sand. In particular, the end plates 145 and 150 prevent the movement of the elements which would adversely affect the operation of the fuse.

Upon our view of Grzeczowski, we find no evidence within Grzeczowski to those skilled in the art that the winding supports need to be defined as a single structure so as to prevent movement of the winding supports. In fact, Grzeczowski teaches just the contrary that the winding supports are separate elements not connected together. Therefore, we find that the Examiner has no substantial evidence that it was either known to one of ordinary skill in the art or suggested to one of ordinary skill in the art to modify the Grzeczowski reference to obtain the invention as recited in Appellants' claims 1 and 16.

Appellants' reliance on **Howard v. Detroit Stove Works** for establishing a material fact is misplaced. In fact, our reviewing court has counseled the PTO that there are no *per se* rules. In **In re Ochiai**, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995) the Examiner had relied on case law for a general obvious rule. The Federal Circuit stated that no such *per se* rules exist. *See Ochiai*, 71 F.3d at 1570, 37 USPQ2d at 1132. Cir. 1995). The Court stated there is not "Durden

obviousness rejections" or "Albertson obviousness rejections," but rather only section 103 obviousness rejections. *Id.* This was further explained by our predecessor Court by stating "[n]ecessarily it is facts appearing in the record, rather than prior decisions in and of themselves, which must support the legal conclusion of obviousness under 35 U.S.C. § 103." *In re Cofer*, 354 F.2d 664, 667, 148 USPQ 268, 271 (CCPA 1966).

In view of the foregoing, we will not sustain the rejection of claims 1 through 4, 7 through 12, 16 through 21 and 24 through 27 under 35 U.S.C. § 103 as being unpatentable over Grzeczkowski. In particular, we note that all the claims recite that at least a portion of both the winding supports system is defined by a single structure.

Now we will turn to the rejection of claims 5 and 22 under 35 U.S.C. § 103 as being unpatentable over Grzeczkowski in view of Knapp and claims 6 and 23 under 35 U.S.C. § 103 as being unpatentable over Grzeczkowski in view of Knapp and Cameron. Upon our view of Knapp and Cameron, we fail to find that either reference teaches or suggests a single structure for providing a pair of winding supports as required by the claims. Therefore, we will not sustain these rejections as well.

Appeal No. 2001-0114  
Application 09/240,712

Therefore, we will not sustain the Examiner's decision in  
rejecting claims 1 through 12 and 16 through 27 under 35 U.S.C.  
§ 103.

**REVERSED**

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

MRF:pgg

Appeal No. 2001-0114  
Application 09/240,712

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